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In re application of
Hideo Yamanaka et al.
Serial No. 09/646,680
Filed: November 4, 2000
For: METHOD AND APPARATUS FOR FILM DEPOSITION

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.144 REQUESTING REVIEW OF THE RESTRICTION REQUIREMENT in the office action mailed on December 21, 2001.

On December 21, 2001, a restriction requirement was mailed to applicants. In this requirement, the examiner held that the claims lack unity under PCT Rules 13.1 – 13.4. In addition to two groups (method and apparatus) an election of species was also required among 13 species. The examiner pointed out which claims correspond to each specie listed. Applicants traversed the restriction requirement in a response filed on January 22, 2002 and requested reconsideration of the requirement. In response to arguments filed stating that the previous grounds of restriction were confusing, the examiner replaced the original requirement with a modified requirement addressing Applicants arguments that certain claims were excluded from the original requirement. The requirement was not made final. Although the requirement was not made final, Applicants filed the instant petition on July 29, 2002. It is noted that a final office action was prepared and mailed by the examiner on October 23, 2002, which did in fact make the requirement final. Accordingly, the instant petition will be decided on its merits.

DECISION

The instant application has been filed under 35 U.S.C. 371 as a national phase application of PCT/JP00/00328 and as such is subject to the unity requirements set out in PCT Rules 13.1 – 13.4 and 37 CFR 1.475, as well as the PCT Administrative Instructions, Annex B. The petitioner's request asserts that, since the application has been filed under 35 U.S.C. 371, the restriction requirement is improper given that the "unity of invention" concept set forth in MPEP 1893.03(d) permits groupings of claims which are linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding technical feature. In the instant petition it is asserted that there is unity of invention among all of the groups since each group shares a common technical feature (i.e. reaction gas means, a catalyzer, heating means, electric field application means, and a susceptor). It is further argued that the examiner admits the existence of at least one common or corresponding special technical feature between the groups.

The PCT Administrative Instructions, Annex B, Part 1 at (b) state that "the special technical features" common to all groupings of inventions shall be defined, as in PCT Rule 13.2, to mean,

"those technical features which each of the claimed inventions, considered as a whole, makes over the prior art." (Emphasis added)

In the instant case, the description and the claims set forth the special technical feature of a film forming method and apparatus (see claims 1 and 23). However, the special technical feature(s) of the film forming method and apparatus has been shown, at pages 6-7 of the office action mailed March 27, 2002, to not make (be) a contribution over the prior art of Miyoshi '241 and Foster et al. '365. Note also that in the October 23, 2002 office action, the examiner states on page 2, lines 8-11, that the special technical features are known. Therefore, the examiner's finding that there is a lack of unity of invention between the groups as set forth in the restriction requirement was correct. The reason for such being that the groups constitute additional inventions not sharing a "special technical relationship" within the meaning of PCT Rule 13.2 since the identified "special technical feature" does not make a contribution over the prior art.

Accordingly, the petition is **DENIED**. The application remains in pending status awaiting a response to the office action mailed October 23, 2002.



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